

Patent Application No. 09/683,281

**REMARKS**

This Amendment is in response to the Office Action dated January 28, 2004. In the Office Action, claim 6 was rejected under 35 USC §112, claim 12 was rejected under 35 USC §102, and claims 1-11 and 13-16 were rejected under 35 USC §103. By this Amendment, claims 1, 5, 7, 12, 13 and 15 are amended, claim 16 is canceled, and claims 17-19 are added. Currently pending claims 1-15 and 17-19 are believed allowable, with claims 1, 5, 7, 10, 12, 13 and 15 being independent claims.

**CLAIM REJECTIONS UNDER 35 USC §112:**

Claim 6 was rejected under the second paragraph of 35 USC §112 as containing insufficient antecedent basis in its claim limitation. By this Amendment, claim 6 is amended to include sufficient antecedent basis to overcome the rejection. The scope of claim 6 is not changed and no new matter is introduced to the claim.

**CLAIM REJECTIONS UNDER 35 USC §103:**

Claims 1-8, 10 and 11 were rejected under 35 USC §103 as obvious over U.S. Patent No. 6,067,080 to Holtzman (hereinafter "Holtzman") in view of U.S. Patent No. 5,737,740 to Henderson et al. (hereinafter "Henderson") and U.S. Patent No. 5,599,122 to Yu (hereinafter "Yu"). Office Action, page 3, paragraph 8 and page 6, paragraph 21.

Claim 1 of the present Application recites, in part, "a pen input apparatus including a plurality of penpoints, and a selector for selecting a specific penpoint from said plurality of penpoints." The Examiner cites Yu as teaching this limitation of claim 1. Office Action, page 3, paragraph 9. Assuming, *arguendo*, that Yu does teach the cited limitation, some suggestion or motivation must be present to modify Yu or combine its teachings with Holtzman or Henderson to establish an obviousness rejection. MPEP 2143. The suggestion must be founded in the prior art, not in the Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) (*citing In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)).

Patent Application No. 09/683,281

As the Examiner indicates, Henderson does not teach or suggest a pen input apparatus including a plurality of pen points. Office Action, page 3, paragraph 9. Likewise, Yu contains no mention or suggestion of combining its teachings with that of Holtzman or Henderson. Holtzman is cited at column 4, lines 55-60 as describing the use of different marking and erasing devices. Id. However, as the Examiner implies, Holtzman does not teach or suggest using a pen input apparatus including a plurality of pen points. Id. Furthermore, it is respectfully submitted that Holtzman teaches away from this limitation since it describes a writing implement adapted for use with a standard dry-erase marker. Holtzman, column 7, lines 27-29 and Fig. 8.

The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Holtzman with the teachings of Henderson and Yu for the purpose of combining multiple digitizer pens into one pen for selecting the desired input operation without changing the holding position of the hand. Office Action, page 5, paragraph 17 and page 24, paragraph 24. However, in making a *prima facie* obviousness rejection, there must be some evidence, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP 2143. "Broad conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence.'" In re Dembicziak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999).

It is respectfully submitted that the Examiner has not provided evidence as to the desirability of making the specific combination that forms the subject matter recited in claim 1. Rather, the Examiner has erroneously construed the teaching of Holtzman, Henderson and Yu through impermissible hindsight in view of the Applicants' disclosure.

For the reasons stated above, it is respectfully submitted that no motivation or suggestion exists to combine the teachings of Yu with those of Holtzman and Henderson. Therefore, a *prima facie* obviousness rejection of claim 1 has not been established by the Examiner and the 35 USC §103 rejection of claim 1 should be withdrawn. In addition, it is respectfully submitted that claim 1 is allowable over the cited art and allowance of claim 1 is requested.

Patent Application No. 09/683,281

Claim 2 recites, in part, "a frequency generator for generating a different frequency for each said penpoint selected by said selector." The Examiner cites Holtzman at column 5, lines 31-35 as teaching this limitation. Office Action, page 3, paragraph 10. However, it is respectfully submitted that the citation offered by the Examiner appears to discuss a unitary sensor array assembly and does not describe or suggest a frequency generator for generating a different frequency for each penpoint selected by a selector. Therefore, it is respectfully submitted that a *prima facie* obviousness rejection of claim 2 has not been established by the Examiner and the 35 USC §103 rejection of claim 2 should be withdrawn. In addition, it is respectfully submitted that claim 2 is allowable over the cited art and allowance of claim 2 is requested.

In addition, claims 2-4 are dependent on and further limit claim 1. Since claim 1 is believed allowable, claims 2-4 are also believed allowable for at least the same reasons as claim 1.

Claim 5 is amended to recite, in part, "a selector for selecting a specific penpoint from a plurality of penpoints in the pen." In rejecting claim 5, the Examiner cites Yu as teaching a pen with multiple penpoints. Office Action, page 4, paragraph 13. As discussed above, however, there is no motivation or suggestion to combine the teachings of Yu with those of Holtzman and Henderson. Therefore, it is respectfully submitted that a *prima facie* obviousness rejection of claim 5 has not been established by the Examiner and the 35 USC §103 rejection of claim 5 should be withdrawn. In addition, it is respectfully submitted that claim 5 is allowable over the cited art and allowance of claim 5 is requested.

Claim 6 is dependent on and further limits claim 5. Since claim 5 is believed allowable, claim 6 is also believed allowable for at least the same reasons as claim 5.

Claim 7 of the present Application recites, in part, "a writing instrument including a plurality of penpoints and allowing a predetermined penpoint to be selected from said plurality of penpoints." The Examiner cites Yu as teaching this limitation of claim 7. Office Action, page 5, paragraph 15. However, as discussed above,

Patent Application No. 09/683,281

it is respectfully submitted that no motivation or suggestion exists to combine the teachings of Yu with those of Holtzman and Henderson. Therefore, it is respectfully submitted that a *prima facie* obviousness rejection of claim 7 has not been established by the Examiner and the 35 USC §103 rejection of claim 7 should be withdrawn. In addition, it is respectfully submitted that claim 7 is allowable over the cited art and allowance of claim 7 is requested.

Claims 8 and 9 are dependent on and further limit claim 7. Since claim 7 is believed allowable, claims 8 and 9 are also believed allowable for at least the same reasons as claim 7.

Claim 10 of the present Application recites, in part, "a penpoint selector for selecting a specific penpoint from said plurality of penpoints." The Examiner cites Yu as teaching this limitation of claim 10. Office Action, page 6, paragraph 22. However, as discussed above, it is respectfully submitted that no motivation or suggestion exists to combine the teachings of Yu with those of Holtzman and Henderson. Therefore, it is respectfully submitted that a *prima facie* obviousness rejection of claim 10 has not been established by the Examiner and the 35 USC §103 rejection of claim 10 should be withdrawn. In addition, it is respectfully submitted that claim 10 is allowable over the cited art and allowance of claim 10 is requested.

Claim 11 is dependent on and further limits claim 10. Since claim 10 is believed allowable, claim 11 is also believed allowable for at least the same reasons as claim 10.

Claim 13 was rejected under 35 USC §103 as obvious over Holtzman in view of Henderson. Office Action, page 7, paragraph 25. Claim 13 is presently amended to recite, in part, "changing an output frequency of a frequency generator based on a selected penpoint from a plurality of penpoints contained within a pen." No new matter is introduced by this amendment and support for the amendment can be found at least at paragraphs 42 and 61 of the Application. Furthermore, it is respectfully submitted that the above-quoted limitation of claim 13 is not described or suggested in the cited art. Thus, for at least this reason, claim 13 is believed allowable and such allowance of claim 13 is respectfully requested.

Patent Application No. 09/683,281

Claim 14 is dependent on and further limits claim 13. Since claim 13 is believed allowable, claim 14 is also believed allowable for at least the same reasons as claim 13.

Claim 15 was rejected under 35 USC §103 as obvious over Holtzman in view of Henderson. Office Action, page 7, paragraph 25. Claim 15 is presently amended to recite, in part, "changing an output frequency of a frequency generator based on a selected penpoint from a plurality of penpoints contained within a pen." No new matter is introduced by this amendment and support for the amendment can be found at least at paragraphs 42 and 61 of the Application. Furthermore, it is respectfully submitted that the above-quoted limitation of claim 15 is not described or suggested in the cited art. Thus, for at least this reason, claim 15 is believed allowable and such allowance of claim 15 is respectfully requested.

CLAIM REJECTIONS UNDER 35 USC §102:

Claim 12 was rejected under 35 USC §102 as anticipated by Holzman. Claim 12 is presently amended to recite, in part, "the pen including a plurality of penpoints." No new matter is introduced by this amendment and support for the amendment can be found at least at paragraph 39 of the Application. Furthermore, it is respectfully submitted that the above-quoted limitation of claim 12 is not described or suggested in Holzman. Thus, for at least this reason, claim 12 is believed allowable and such allowance of claim 12 is respectfully requested.

NEW CLAIMS:

By this Amendment, claims 17-19 are added to the present Application. No new matter is introduced by claims 17-19 and support for claims 17-19 can be found at least at paragraphs 42 and 61 of the Application. Furthermore, it is respectfully submitted that the limitations of claims 17-19 are not described or suggested in the cited art. Thus, for at least this reason, claims 17-19 are believed allowable and such allowance of claims 17-19 is respectfully requested.

Patent Application No. 09/683,281

CLAIM AMENDMENTS:

Claims 1 and 7 are amended to replace the words "having" with "including" in order to clarify the claimed invention. No new matter is introduced by these amendments, and the amendments are not made to overcome prior art or for reasons of patentability.

## CONCLUSION

In view of the forgoing remarks, it is respectfully submitted that this case is now in condition for allowance and such action is respectfully requested. If any points remain at issue that the Examiner feels could best be resolved by a telephone interview, the Examiner is urged to contact the attorney below.

No fee is believed due with this Amendment, however, should a fee be required please charge Deposit Account 50-0510. Should any extensions of time be required, please consider this a petition thereof and charge Deposit Account 50-0510 the required fee.

Respectfully submitted,



Ido Tuchman, Reg. No. 45,924  
Law Office of Ido Tuchman  
69-60 108th Street, Suite 503  
Forest Hills, NY 11375  
Telephone (718) 544-1110  
Facsimile (718) 544-8588

Dated: April 28, 2004